

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hiroshi KISHI et al.

Group Art Unit: 2629

Application No.: 09/698,441

Examiner: A. ABDULSELAM

Filed: October 30, 2000

Docket No.: 107427

For: CONTROL APPARATUS AND METHOD FOR INPUT SCREENS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the August 31, 2006 Final Rejection in this application. A Notice of Appeal and fee in the amount of \$500 is filed concurrently herewith. The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 15-0461.

**I. Status of Pending Claims**

Claims 1-20 are pending in this application. Claims 8-14, 17 and 20 are allowed and claims 1-7, 15, 16, 18 and 19 stand finally rejected. No amendments are being filed with this request.

**II. Grounds of Rejection Presented For Review**

The following grounds of rejection are presented for review: the August 31, 2006 Final Rejection rejects claims 1-7, 15, 16, 18 and 19 under 35 U.S.C. §103(a) over JP Patent Publication No. 11-198745 to Wataru et al. Claims 1, 4, 15, 16, 18 and 19 are the only rejected independent claims.

Applicants respectfully submit that the legal and factual basis of the prior art rejection contain clear and factual deficiencies.

**III. Legal Deficiency By Omission of Essential Elements Needed for §103(a) Prima Facie Rejection**

In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicants' disclosure. Applicants respectfully submit that the Final Rejection fails to satisfy at least the first and third criteria.

### A. Independent Claims 1, 15 and 18

The Final Rejection acknowledges that Wataru does not disclose an operation nullification canceller or an operation nullification cancel means "that cancels prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined period of time has elapsed since the prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance," as recited in independent claim 1, and as similarly recited in independent claim 15 (emphasis added). Similarly, the Final Rejection acknowledges that Wataru does not disclose "canceling prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined time period has elapsed since the prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance," as recited in independent claim 18 (emphasis added).

However, the Final Rejection asserts that it would have been obvious to substitute an "automated" switching means for the release switches (12, 13) of Wataru because "it is generally been recognized that the use of a conventional control to automate a previously manual operation involves only routine skill in the art" (see *In re Venner*, 120 USPQ 193 (CCPA 1958)). The Final Rejection further asserts that "[o]ne of ordinary skill in the art would have ascertained that automation with respect to switching involves elapsing time before and after the use of automatic switches and hence would be obvious to set the desired interval of time." The proposed modification of automating the release switches (12 and 13) of Wataru would render them unsatisfactory for its intended purpose and would change the principle of operation in violation of MPEP §2143.01. In fact, Wataru teaches away from such a combination or modification.

The release switches 12 and 13 of Wataru detect whether the driver can touch the navigation operation buttons so as to prohibit the driver's operation of the navigation system while driving the car (Wataru at Abstract and paragraphs [0006], [0018]-[0021], and [0024]). If the driver can operate the release switches 12 and 13 of Wataru, the driver cannot operate the navigation system. When the release switches 12 and 13 of Wataru are simultaneously operated, a passenger, for example, can perform the input operation (Wataru at paragraphs [0005]-[0006]). Thus, by automating the release switches 12 and 13 of Wataru, the switches would no longer detect when the driver is holding the steering wheel and the safety feature of the system of Wataru, i.e. prohibiting the driver's operation of the navigation system, would no longer be achieved. Therefore, modifying the release switches of Wataru to be "automated" as alleged by the Final Rejection would render the release switches unsatisfactory for their intended purpose and change the principle of operation of the release switches in violation of MPEP §2143.01.

The Final Rejection also improperly relies on *In re Venner* for its motivation for automating the release switches 12 and 13 of Wataru. MPEP §2144.04 clearly states that "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may

use the rationale used by the court." The court held in *In re Venner* that broadly providing an automatic or mechanical means to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art (see MPEP §2144.04 III). However, as discussed above, the Final Rejection relies on *In re Venner* to assert that it would have been obvious to substitute an "automated" switching means for the release switches (12, 13) of Wataru since it has generally been recognized that the use of conventional control to automate a previously manual operation involves only routine skill in the art. *In re Venner* does not support this assertion. The deficiency of Wataru is not similar to the facts in *In re Venner*. One cannot "automate" the release switches of Wataru and accomplish the same result, i.e., permitting a passenger to access the navigation system if the driver can access the release switches 12 and 13, which prohibits the driver's operation of the navigation system while driving the car. Thus, the Final Rejection improperly relies on *In re Venner*. For at least these reasons, one of ordinary skill in the art would not have been motivated to modify the release switches of Wataru as alleged by the Final Rejection. Therefore, the Final Rejection appears to rely on improper hindsight reasoning to achieve the claimed invention.

Furthermore, even if there was motivation to modify Wataru to be "automated," the Final Rejection fails to satisfy the third criteria. As discussed below in detail, "automated" release switches would not achieve the claimed invention. In particular, Wataru does not disclose an operation nullification canceller or an operation nullification cancel means "that cancels prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined time period has elapsed since the prohibition against the inputting of the predetermined operation preformed by the operator as the operator guidance," as recited in independent claims 1 and 15, and as similarly recited in independent claim 18 (emphasis added). Thus, for at least these reasons, the rejection is legally deficient.

#### **B. Independent Claims 4, 16 and 19**

The Final Rejection also acknowledges that Wataru does not disclose an operation nullification device or operation nullification means that "is constructed to judge whether or not the predetermined condition has been fulfilled, depending on the number of dummy switches included in information displayed by the display device," as recited in independent claim 4, and as similarly recited in independent claim 16 (emphasis added). Similarly, the Final Rejection acknowledges that Wataru does not disclose "judging whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number dummy switches included in information displayed by the display device," as recited in independent claim 19 (emphasis added).

However, the Final Rejection alleges that it would have been obvious to utilize a speed sensor (10) and a control device (ECU) of Wataru for the purpose of establishing a relationship between the

condition of the car and the images on the display. One of ordinary skill in the art would not have been motivated to modify Wataru as alleged by the Final Rejection.

The ECU of Wataru only judges the condition of the car based on the vehicle speed to determine whether or not to perform the alter operation by touch switches (Wataru at paragraph [0015]). The Final Rejection fails to provide motivation for modifying Wataru. In fact, the Final Rejection appears to be relying on impermissible hindsight reasoning to achieve the claimed invention. Thus, the asserted modification is improper.

Further, as discussed in detail below, even if there was motivation to modify as alleged by the Final Rejection, the Final Rejection fails to satisfy the third criteria. The ECU of Wataru would not judge whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number of dummy switches included in the information displayed by the display device, as recited in independent claims 4, 16 and 19. Thus, for at least these reasons, the rejection is legally deficient.

#### **IV. Factual Deficiency**

As discussed above, there would have been no motivation to modify Wataru as alleged by the Final Rejection. However, even if there were motivation to modify Wataru as alleged by the Final Rejection, the claimed invention would not have been achieved.

##### **A. Independent Claims 1, 15 and 18**

In particular, even if there was motivation to modify the release switches 12 and 13 of Wataru to be "automated," Wataru does not disclose an operation nullification canceller or an operation nullification cancel means as recited in independent claims 1, 15 and 18. As discussed above, the release switches 12 and 13 of Wataru detect whether the driver can touch the navigation operation buttons so as to prohibit the driver's operation of the navigation system while driving the car (Wataru at Abstract and paragraphs [0006], [0018]-[0021], and [0024]). If the driver can operate the release switches 12 and 13 of Wataru, the driver cannot operate the navigation system. Accordingly, if one were to "automate" the release switches of Wataru as alleged by the Office Action and maintain their function, the "automated" switches would only automatically detect whether the driver can touch the navigation operation buttons, i.e., automatically determine whether the driver is holding on to the steering wheel. Thus, the "automated" release switches would not cancel prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance if a predetermined period of time has elapsed since the prohibition against the inputting of the predetermined operation performed by the operator as the operator guidance, as in the claimed invention.

Accordingly, the characterization of Wataru asserted by the Final Rejection to support the rejection of independent claims 1, 15 and 18, as well as claims 2 and 3 that depend from claim 1, is factually incorrect.

**B. Independent Claims 4, 16 and 19**

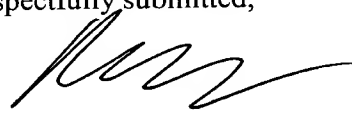
Further, the alleged modification of the ECU of Wataru would not judge whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number of dummy switches included in the information displayed by the display device, as recited in independent claims 4, 16 and 19. As discussed above, the ECU of Wataru only judges the condition of the car based on the vehicle speed to determine whether or not to perform the alter operation by touch switches (Wataru at paragraph [0015]). Further, if the driver simultaneously presses the release switches 12 and 13, the passenger, for example, can operate the touch switches of Wataru. This safety feature of Wataru prohibits the driver's operation of the navigation system while driving. Thus, even if there was motivation to modify Wataru so that control device establishes a relationship between the condition of the car and the images on the display, the modified control device of Wataru would not judge whether or not a predetermined traveling condition related to operation of the vehicle has been fulfilled, depending on the number of dummy switches included in the information displayed by the display device, as recited in independent claims 4, 16 and 19.

Accordingly, the characterization Wataru asserted by the Final Rejection to support the rejection of independent claims 4, 16 and 19, as well as claims 5-7 that depend from claim 4, is factually incorrect.

**V. Conclusion**

For all of the reasons discussed above, it is respectfully submitted that the Final Rejection include legal and factual deficiencies and that all the pending claims are in condition for allowance. Because there is no motivation to modify the Wataru as alleged by the Final Rejection and the Wataru fails to teach or suggest each and every feature recited in the pending claims and, withdrawal of the Final Rejection and allowance of this application is respectfully requested.

Respectfully submitted,



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